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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/672,523
Filing Date: September 27, 2000
Appellant(s): JOSEPH ET AL.

Elena Dreszer
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/17/2010 appealing from the Office action mailed 11/18/2009 .

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner agrees with the statement identifying the related appeals, interferences, and judicial proceedings in the brief.

(3) Status of Claims

The examiner agrees with the statement identifying the status of the claims in the brief. The following is a list of claims that are rejected and pending in the application:

Claims 10, 11, 13-24, 27, 33, 38, 39, 41-43, 45-55, 57, 63, 260, 262.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection, reproduced from the Office action mailed 11/18/2009, are applicable to the appealed claims:

Quote:

“

Substitute Oath/Declaration

3. Substitute declaration filed on 3/30/2009 is entered but found defective.

Claims 10-11, 13-24, 27, 33, 38-39, 41-43, 45-55, 57, 63, 260, and 262 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the Substitute declaration is set forth in the discussion below in this Office action.

The Substitute reissue declaration filed 3/30/2009 with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a) (1) and MPEP § 1414.

The filed Substitute declaration does not identify the existence of an error in the specification, drawings, or claims, which error causes the original patent to be defective.

In re Wilder, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984). All that is needed for the oath/declaration statement as to error is the identification of "at least one error" relied upon. In identifying the error, it is sufficient that the reissue oath/declaration identify a single word, phrase, or expression in the specification or in an original claim, and how it renders the original patent wholly or partly inoperative or invalid. The filed declaration does not do this. Instead it merely states that the original claims did not cover certain embodiments/language being presented by new claim 10. **This statement of error is not sufficient because it does not identify a single word, phrase, or expression in the specification or in an original claim (s) 1-9, and how it renders the original patent wholly or partly inoperative or invalid.** The statement filed is no better than saying in the reissue declaration that this "application is being filed to correct errors in the patent which may be noted from the change made by adding new claim 10", see MPEP 1414, II, C.

Claim Rejections - 35 USC § 251

4. Claims **10-11, 13-24, 27, 33, 38-39, 41-43, 45-55, 57, 63, 260, and 262** are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

Note: Please also refer to the arguments provided above in support of this rejection.

The "recapture rule," prevents a patentee from regaining, through a reissue patent, subject matter that the patentee surrendered in an effort to obtain allowance of claims in the patent sought to be reissued. *In re Clement*, 131 F.3d 1464, 1468, 45 USPQ2d 1161, 1164 (Fed. Cir. 1997).

Clement discusses a three-step test for analyzing recapture:

Step 1 involves a determination of whether and in what aspect any claims sought to be reissued are broader than the patent claims.

Step 2 involves a determination of whether the broader aspects of the reissue application claims relate to surrendered subject matter.

Step 3 is applied when the broadening relates to surrendered subject matter and involves a determination whether the surrendered subject matter has crept into the reissue application claim.

Substep (3): if the reissue claim is broader in some aspects, but narrower in others, then:

- (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim;
- (b) if the reissue claim is narrower in an aspect germane to [a] prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.

The Federal Circuit in *North American Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d at 1350, 75 USPQ2d 1545 (Fed. Cir. 2005) further refined Substep (3) (a) of *Clement* to define "broader in an aspect germane to a prior art rejection" to mean broader with respect to a specific limitation

- (1) added to overcome prior art in prosecution of the application which matured into the patent sought to be reissued and
- (2) eliminated in the reissue application claims.

"Surrendered subject matter" is defined in connection with prosecution history estoppel in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 733-34, 122 S. Ct. 1831, 1838, 62 USPQ2d 1705, 1710-11 (2002). A patentee's decision to narrow his claims through amendment "may be presumed to be a general disclaimer of the territory between the original claim and the amended claim." *Exhibit Supply*, 315 U.S., at 136-137, 62 S. Ct. 513. "...in determining whether 'surrender' of subject matter has occurred, the proper inquiry is whether an objective observer viewing the prosecution history would conclude that the purpose of the patentee's amendment or argument was to overcome prior art and secure the patent." *Kim v. ConAgra Foods, Inc.*, 465 F.3d 1312, 1323, 80 USPQ2d 1495, 1502 (Fed. Cir. 2006).

A further opinion, *Ex parte Eggert*, 67 USPQ2d 1716 (BPAI 2003), issued by the Board of Appeals and Interferences as a precedential opinion, is also part of the recapture precedent applicable to proceedings before the United States Patent & Trademark Office (USPTO). *Eggert* was entered on May 29, 2003, prior to the Federal Circuit's *North American Container* decision. In *Eggert* the majority held that the

surrendered subject matter was the rejected claim **only** rather than the amended portion of the issued claim.

A published precedential opinion of the Board is binding unless the views expressed in an opinion in support of the decision, among a number of things, are inconsistent with a decision of the Federal Circuit. In this case, the majority view in *Eggert* is believed to be inconsistent with the subsequent Federal Circuit decision in *North American Container* with respect to the principles governing application of Substep (3)(a) of *Clement*. See: *Ex parte Franklin C. Bradshaw and Thomas L. Soderman*, (Appeal 2006-2744 Bd. Pat. App. & Int. July 19, 2007) (available in Application 09/664,794 and at <http://www.uspto.gov/web/offices/dcom/bpai/its/fd062744.pdf>); *Ex parte Raanan Liebermann*, (Appeal 2007-0012 Bd. Pat. App. & Int. May 2007) (available in Application 09/603,247 and at <http://www.uspto.gov/web/offices/dcom/bpai/its/fd070012.pdf>); *Ex parte Willibald Kraus* (Appeal 2005-0841 Bd. Pat. App. & Int. April 2005) (available in Application 08/230,083 and at <http://www.uspto.gov/web/offices/dcom/bpai/its/fd050841.pdf>)

As set forth in the above BPAI decisions, based on *North American Container* and other court decisions, surrendered subject matter is considered the subject matter of an application claim which was amended or canceled and, on a limitation-by-limitation basis, the territory falling between the scopes of

- (a) the application claim which was canceled or amended and
- (b) the patent claim which was ultimately issued.

Accordingly, the "surrendered subject matter" that may not be recaptured through reissue should *be presumed* to include subject matter broader than the patent claims in a manner directly related to

- (1) limitations added to the claims by amendment (either by amending an existing claim or canceling a claim and replacing it with a new claim with that limitation) to overcome a patentability rejection and
- (2) limitations argued to overcome a patentability rejection without amendment of a claim.

However, when reissue claims are narrower than the patent claims with respect to features other than the surrender generating feature, then the reissue claims may be materially narrowed relative to the claims prosecuted and issued in the patent, thereby avoiding the recapture rule.

As explained in *Hester Industries, Inc. v Stein, Inc.*, 142 F.3d 1472,1480, 46 USPQ2d 1641, 1647 (Fed. Cir. 1998), the recapture rule is avoided when two conditions are satisfied. First, an aspect of the invention must have been overlooked (e.g., not claimed)

during patent prosecution. Second, the reissue claim must have been materially narrowed with respect to this overlooked aspect of the invention.

In summary, the recapture rule is avoided if the reissue claim was materially narrowed in other respects compared to its broadening surrendered aspect. A reissue claim is materially narrowed and thus avoids the recapture rule when limited to aspects of the invention:

- (1) which had not been claimed and thus were overlooked during prosecution of the original patent application; and
- (2) which patentably distinguish over the prior art.

In the instant case, the reissue claims satisfy the "recapture rule" preventing a patentee from receiving a reissue patent as per both *Clement three steps test* and *Hester Industries, Inc, v Stein, Inc., 142 F.3d 1472,1480, 46 USPQ2d 1641, 1647 (Fed. Cir. 1998)* as analyzed below:

A: Analysis per *Clement three-step test*:

New claims 10-11, 13-24, 27, 33, 38-39, 41-43, 45-55, 57, 63, 260, and 262 are broader than the patented claims 1-9 because they do not include limitations recited in the patented claims 1-9. There was a surrender of subject matter in the original application prosecution and the broadening of the reissue claims is in the area of the surrendered subject matter. The omitted/broadened limitations in the reissue claims are directed to limitations relied upon by the applicant in the original application to make the claims allowable over prior art (At a minimum, the claims require at least one of the following limitations which were argued as the patentable feature for the issued independent claims 1, 6, 7, and 9 in the 08/233,908 application: *a source of a data stream providing a series of time division multiplexed packets,*

ones of which contain auxiliary data that represent a video program, and others of which represent a distributed computing application associated with said video program, and wherein said distributed computing application is repetitively transmitted independent of receiving client computer apparatus during times that said video program is transmitted OR a client computer, which includes a packet selector connected to said source for selecting and directing packets containing said auxiliary data representing said video program to a video signal processor and selecting and directing packets containing said associated distributed computing application to a further processor OR further processor including means to assemble said distributed computing application and execute said distributed computing application to form an interactive video program in which execution of said distributed computing application alters said video program OR a source of a time division multiplexed packet signal including a plurality of distributed computing applications, each distributed computing application being repetitively transmitted independent of receiving client computer apparatus, and each of said distributed computing applications being in a form of a series of packets OR a first one of packets of a respective series containing data representing an executable code module and including identification information indicating that the first one of packets of said series contains data representing said executable code module OR the client computer extracts said directory module from the data stream and using data contained in the directory module extracts packets associated with said distributed computing application and builds said distributed computing application and executes said distributed computing application OR read/write memory, coupled to the system bus; a data stream input/output adapter, coupled between the data stream receiver and the system bus, for receiving the extracted distributed computing application representative data from the data stream receiver, and storing it in the read/write memory, and having a control output terminal coupled to the selection control input

terminal of the data stream selector, for producing the selection control signal; and a processor, coupled to the system bus, for controlling the data stream input/output device to generate a selection control signal selecting a specified one of the plurality of data streams, and for assembling and executing the distributed computing application stored in the read/write memory.). The filed re-issue claims are broader than the original patent claims by not including the surrender-generating limitations (as described above) will be barred by the recapture rule even though there is narrowing of the claims not related to the surrender-generating limitation. As stated in the decision of *In re Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165, if the reissue claim is broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim. *Pannu v. Storz Instruments Inc.*, *supra*, then brings home the point by providing an actual fact situation in which this scenario was held to be recapture.

B: Analysis as per *Hester Industries, Inc. v Stein, Inc.*: In order to satisfy the two conditions, the subject matter that materially narrows the reissue claims should be the overlooked aspect of the original invention claimed in the patent. In the instant case, the reissue claims do not include any subject matter of the patented claims (independent patented claims 1, 6, 9, 10) but instead the subject matter that materially narrows the reissue claims is directed to a distinct

and different invention and it is not the overlooked aspect of the original invention.

“

(10) Response to Argument

A) The rejection of claims 10-11, 13-24, 27, 33, 38-39, 41-43, 45-55, 57, 63, 260 and 262 under 35 USC 251 as being based upon a defective Reissue Declaration.

The appellant argues that the above rejection is incorrect because the appellant has satisfied MPEP 1414 II (B) by specifying one of the errors on which reissue is based by stating the following in the substitute reissue declaration filed March 30, 2009, see AB pages 10-12, “ This invention is distinct from the invention claimed in the original patent; and is not in any way claimed in the patent. This error is addressed in this reissue by including claims directed to method and system of facilitating ordering an item, where the order is placed in response to a single action by the user. In particular, the error is addressed by the presentation of claims 10, 28,260, and their respective dependent claims, drawn to this previously unclaimed invention. The substitute reissue declaration thus clearly identifies the existence of an error in the claims, due to the original claims not addressing the newly-addressed invention covered by the submitted claims. Applicants respectfully request that the declaration submitted March 30, 2009 be considered, and that the rejection be reversed. “. However, the examiner did not find this argument persuasive, as already

discussed in the Office action mailed 11/18/2009, see pages 5-6, because it does not satisfy MPEP 1414 II (c) which states the following:

“....A statement of “...failure to include a claim directed to...” and then presenting a newly added claim, would not be considered a sufficient “error” statement *because< applicant has not pointed out what the other claims lacked that the newly added claim has, or vice versa. Such a statement would be no better than saying in the reissue oath or declaration that “this application is being filed to correct errors in the patent which may be noted from the change made by adding new claim 10.” In both cases, the error has not been identified....”.

The examiner interprets that the filed Substitute declaration does not identify a single word, phrase, or expression in the specification or in an original claim, and how it renders the original patent wholly or partly inoperative or invalid. Instead the declaration merely states that the original claims did not cover certain embodiments/language being presented by new claim 10. The statement filed is no better than saying in the reissue declaration that this “application is being filed to correct errors in the patent which may be noted from the change made by adding new claims 10, 28, 260 and their dependent claims and cancelling all the old patented claims 1-9, see MPEP 1414, II wherein it amounts to that the error has not been identified. Further it can also be interpreted that the opportunity for filing a Reissue application is being used to cancel all the earlier patented claims belonging to one embodiment and instead filing all new claims belonging to a new distinct embodiment/invention which if filed originally should have been subject to restriction.

B) The rejection of claims 10-11, 13-24, 27, 33, 38-39, 41-43, 45-55, 57, 63, 260 and 262 under 35 USC 251 as “being an improper recapture of

broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based”.

The applicant argues that the above rejection is incorrect because as per MPEP 1412 .02 (I) C “that if the reissue claims are claiming additional inventions or embodiments not originally claimed, then recapture will not be present: If surrendered subject matter has been entirely eliminated from a claim in the reissue application, or has been in any way broadened in a reissue application claim, then a recapture rejection under 35 U.S.C. §251 is proper and must be made for that claim. If, however, the reissue claim(s) are really claiming additional inventions/embodiments/species not originally claimed (i.e., overlooked aspects of the disclosed invention), then recapture will not be present. 14 (Emphasis added.) “, see AB page 17. The examiner respectfully disagrees because the above excerpt from MPEP 1412 .02 (I) C is conditional that is reissue claims claiming additional inventions/embodiments/species can be allowed only if the originally patented claims are not canceled, as is evident from the MPEP 1412 .02 (I) C stating the following:

“.....If surrendered subject matter has been entirely eliminated from a claim in the reissue application, or has been in any way broadened in a reissue application claim, then a recapture rejection under 35 U.S.C. 251 is proper and must be made for that claim.

If, however, the reissue claim(s) are really claiming additional inventions/embodiments/species not originally claimed (i.e., overlooked aspects of the disclosed invention), then recapture will not be present. Note the following examples:

Assume that, in the original prosecution of the patent, applicant claimed a method of making a glass lens, where the ion implantation step used a molten bath to diffuse ions into the lens, and that step had to be amended to recite a pressure of 50-60 PSI and temperature between 150-200 degrees C to define over the art. That pressure and temperature range-set is “frozen” in place for any molten bath ion implantation claim, and it cannot be deleted or broadened by reissue. However, if in the original application, applicant had failed to claim a disclosed embodiment to plasma ion implantation (i.e., using a plasma stream rather

than a molten bath to provide the ions), that is a proper 35 U.S.C. 251 error, which can be corrected by reissue. **Applicant can, in a reissue application, add a set of claims to plasma ion implantation, without including the “50-60 PSI and temperature between 150-200 degrees C” limitation.** The “50-60 PSI - 150-200 degrees C limitation” is totally irrelevant to plasma implantation and is clearly wrong for the plasma species/embodyment, as opposed to being right for the molten bath species/embodyment. Also, if in the original application, applicant failed to claim the method of placing two lenses made by the invention in a specified series to modulate a laser for cutting chocolate, that too is a proper 35 U.S.C. 251error, which can be corrected by reissue. In this lens placement method, it does not matter how the specific lens having the implanted ion gradient was made, and the “50-60 PSI and temperature between 150-200 degrees C” limitation is again not relevant.”.

From the above given example the examiner understand that new claims claiming additional inventions/embodyments/species can be added and filed in a Reissue application without canceling all the originally patented claims. In the instant case the appellant has canceled all the previously patented claims which were amended before being allowed and is adding claims directed to a distinct new invention and therefore they do not satisfy MPEP 1412.02 (I) (C).

The applicant argues that “The requirements for a 35 USC 251 Rejection for improper Recapture of the Reissue Claim Subject Matter Have Not Been Met”, see AB pages 17-22. The applicant argues , see AB pages 19-20,” The examiner sets forth an erroneous characterization of the law of recapture under 35 U.S.C. § 251. As explained in the section above, Hester Industries clearly rejects the proposition that the invention that is the subject matter of reissue claims must be the same as the invention in the original patent. Rather, according to Hester Industries, the essential test under the “original patent” clause of § 251, is whether a person of ordinary skill in the art would identify within the specification, the subject matter of the reissue claims as having been invented and disclosed by patentees. 17”. The examiner respectfully disagrees because the examiner has not argued that “that is the subject matter of reissue claims must be

the same as the invention in the original patent". Instead, as analyzed above, reissue claims can have additional inventions/embodiments/species in a Reissue application but without canceling all the originally patented claims. By not canceling the originally patented claims the additional reissue claims claiming additional inventions/embodiments/species will not be subject to recapture rejection. Since in the instant case, all the originally patented claims have been canceled it implies that the filed reissue claims are broader than the original patent claims by not including the surrender generating limitations [see details provided in pages 9-11 of the office action mailed 11/18/2009] and as per Analysis per clement three-step test the filed reissue claims claiming a different embodiment/distinct invention from all the originally patented and now canceled claims 1-9 are to be barred by the recapture rule even though there is narrowing of the claims not related to surrender-generating limitation. As stated in the decision of *In re Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165, if the reissue claim is broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim. *Pannu v. Storz Instruments Inc.*, *supra*, then brings home the point by providing an actual fact situation in which this scenario was held to be recapture.

The applicant further argues, see AB pages 20-22, " Claims 10-11, 13-24, 27, 33, 38-39, 41-43, 45-55, 57, 63,260 and 262 in the instant application cover "overlooked aspects" of the disclosed invention, which fall within the exception to the rule against recapture explained in *Hester Industries* and as included in the third step of the three part test²⁴ and included in MPEP § 1412.02(I)(C).....". The examiner respectfully disagrees. As already discussed and

analyzed above the MPEP § 1412.02(I)(C) while allowing to claim overlooked aspects it is desired that the originally patented claims are not completely canceled, as analyzed above. Therefore, as already analyzed in the Office action mailed 11/18/2009, see pages 6-12, *Hester Industries, Inc. v Stein, Inc.*, and the analysis and discussions presented above in this letter, the examiner interprets that in order to satisfy the two conditions, the subject matter that materially narrows the reissue claims should **be the overlooked aspect of the original invention claimed in the patent**. In the instant case, the reissue claims do not include any subject matter of the patented claims (independent patented claims 1, 6, 9, 10) but instead the subject matter that materially narrows the reissue claims is directed to a distinct and different invention and that is not the overlooked aspect of the original invention.

For the above reasons, it is believed that the rejections should be sustained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Respectfully submitted,

/Yogesh C Garg/
Primary Examiner, Art Unit 3625

Conferees:

Jeffrey A Smith /jas/
Supervisory Patent Examiner, Art Unit 3625

Vincent Millin/vm/
Appeal Practice Specialist, TC 3600